



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/03/97 372,876	06/12/97	ROBBING	061137011882

QM11/0603

JONATHAN P. OSHA
FISH & RICHARDSON
601 THIRTEENTH STREET NW
WASHINGTON DC 20005

EXAMINER	
PATTERSON, M	
ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 06/03/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/873,876

Applicant(s)

Steven E. Robbins

Examiner

Marie Patterson

Group Art Unit

3728

☒ Responsive to communication(s) filed on May 8, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-18 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on May 8, 1998 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3208

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. A new action on the merits follows.

Drawings

2. The corrected or substitute drawings were received on 5/8/98. These drawings are approved by the Examiner and the Draftsman.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1-3, 7-11, and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Marc.

Art Unit: 3208

Marc shows a sole (13) made from PVC foam (column 3 lines 41-46) which inherently has a resiliency index as claimed.

5. Claims 1, 2, 7-10, and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Pyle.

Pyle shows a sole (14) made from vinyl nitrile (column 3 lines 46-54) which inherently has a resiliency index as claimed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-6 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Marc or Pyle.

Marc or Pyle as discussed above shows a sole element substantially as claimed except for the exact thickness of the sole. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the sole a thickness of between 12mm and 20mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Art Unit: 3208

Response to Arguments

8. Applicant's arguments filed 5/8/98 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the materials used, Pyle and Marc teach the use of PVC foam and vinyl nitrile which as discussed in the Declaration filed 5/8/98, fall into the resiliency index desired and claimed.

9. The Declaration under 37 CFR 1.132 filed 5/8/98 is sufficient to overcome the rejection of claims 1-18 based upon Moronaga, however a new rejection has been applied in view of the information in the Declaration.

10. **Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1148. Facsimile correspondence for this application should be sent to (703) 305-3579.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie Patterson whose telephone number is (703)308-0069.



**Marie Patterson
Primary Examiner
Art Unit 3728**

MDP
May 27, 1998